



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,335	07/03/2003	Walter A. Zohmann	10012.7	5090
21999	7590	04/10/2007	EXAMINER	
KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111			THANH, LOAN H	
			ART UNIT	PAPER NUMBER
			3763	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/10/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/613,335

Applicant(s)

ZOHMANN, WALTER A.

Examiner

LoAn H. Thanh

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/12/07 has been entered.

### ***Response to Amendment***

Applicant has only argued and have not amended the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zohmann ( USPN 6,558,353) in view of Sorenson et al. (USPAP 2002/0123723).

Zohmann discloses the invention as substantially claimed. Zohmann discloses a needle apparatus for administering a peripheral nerve block comprising a hollow needle 50 having a fenestration/side port 54, a needle hub 40 and a stylet cap 20 coupled to a

Art Unit: 3763

stylet 30 and slidable within the needle 50 and needle hub 40. Zohmann also discloses at least one fenestration indicator 48,48 for visual and tactual verification of the orientation of the fenestration. See figures 1-8, columns 5-8. However, Zohmann does not disclose a plurality of fenestrations. Sorenson et al. discloses a plurality of holes alternating along the length of the needle and longitudinally spaced on alternate sides of the wall with an obturator/stylet 55 to block passage of fluid while the needle is being inserted into the patient. The holes/fenestrations are provided for uniform and optimal dispersion of medication across a range of proximal absorption fields. It would have been obvious to one of ordinary skill in the medical injection art to modify the single fenestration of Zohmann with a plurality of fenestrations as taught by Sorenson et al. to provide a uniform volume and rate of dispersion of therapeutic fluids from the fluid flow path to the target area.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zohmann (USPN 6,558,353) in view of Yang (CN -2201946-Y).

Zohmann discloses the invention as substantially claimed. Zohmann discloses a needle apparatus for administering a peripheral nerve block comprising a hollow needle 50 having a fenestration/side port 54, a needle hub 40 and a stylet cap 20 coupled to a stylet 30 and slidable within the needle 50 and needle hub 40. Zohmann also discloses at least one fenestration indicator 48,48 for visual and tactual verification of the orientation of the fenestration. See figures 1-8, columns 5-8. Zohmann discloses a needle in combination with a stylet. However Zohmann shows one fenestration. Zohmann is silent to a plurality of fenestrations. See Yang figure 1. Yang shows a

Art Unit: 3763

needle with 3 fenestrations. It would have been obvious to one of ordinary skill at the time the invention was made to modify the needle of Zohmann with a plurality of fenestrations as taught by Yang in order to provide a plurality of infusion ports in order to provide increased flow to a larger local target area or in order to provide flow in case one of the fenestrations/ports is occluded.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zohmann (USPN 6,558,353) in view of Ditto (US 7,022,109).

Zohmann discloses the invention as substantially claimed. See above. However, Zohmann does not disclose a plurality of fenestrations. Ditto discloses a plurality of holes 33 at the distal end to deliver medications to the epidural space. The holes/fenestrations are provided for uniform and optimal dispersion of medication and decrease of patient discomfort due to the pressure of the injection. The plurality of holes provides for the dispersion of the pressure. It would have been obvious to one of ordinary skill in the medical injection art to modify the single fenestration of Zohmann with a plurality of fenestrations as taught by Ditto to provide a uniform volume and rate of dispersion of therapeutic fluids with decreased discomfort to the patient by the decreased pressure of the injection via plural holes.

### ***Response to Arguments***

Applicant's arguments filed 01/12/07 have been fully considered but they are not persuasive. Applicant's arguments are not convincing. The Examiner has used the teaching of the secondary references of Sorensen or Yang as teaching more than one aperture. The Examiner is not relying on the teaching of having a plurality of holes

Art Unit: 3763

along the entire length as applicant is arguing. Zohmann discloses 1 port/aperture. The examiner is relying on the teaching of multiple ports at the distal end rather than one port in order to provide multiple outlets for delivery of the drug to the target site in order to provide a different port or path to the target site in case 1 port is blocked. The target site could still be the local target site and a plurality of holes at the distal end would provide uniform delivery.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (571) 272-4966. The examiner can normally be reached on Mon. - Fri. (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3763

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'LoAn H. Thanh', with a stylized flourish at the end.

LoAn H. Thanh  
Primary Examiner  
Art Unit 3763

LT